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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,893	10/24/2003	Kent W. Savage	40059-0008	8706
<div>37526 7590 01/19/2007 RADER, FISHMAN & GRAUER PLLC 10653 SOUTH RIVER FRONT PARKWAY SUITE 150 SOUTH JORDAN, UT 84095</div>			<div>EXAMINER SHAY, DAVID M</div> <div>ART UNIT PAPER NUMBER 3735</div>	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/19/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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Office Action Summary	Application No. 10/692,893	Applicant(s) SAVAGE, KENT W.	
	Examiner david shay	Art Unit 3735	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed* after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on October 17, 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 and 56-97 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 and 56-97 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 17, 2006 has been entered.

Applicant argues, with respect to the drawing correction, that ‘ “hardware in the data processor” refers to circuitry, this feature has been shown as a rectangular box identified by reference character 21 in Figure 1.’ However, the examiner has been unable to locate any such revised drawing Figure, nor has any amendment to the specification been made to identify any new reference character added to any drawing. Thus the drawing objection has been maintained.

With respect to the indefiniteness rejection of claims 63 etc., applicant argues that the language of claim 63: “device is configured to reduce or increase the therapeutic ocular light to simulate gradually decreasing light at dusk or gradually increasing light at dawn”; indicates “that the amount of therapeutic light delivered to the subject may, instead of being merely controlled, simulate gradually decreasing light at dusk or simulate gradually increasing light at dawn” (emphasis added). However, it is well settled that “claim scope is not limited by claim language which suggests or makes optional but do not require steps to be performed, or by claim language that does not limit a claim to a particular structure.” (MPEP 2111.04). Thus the “configured to” language, which by applicant’s own statement merely indicates that the function may be performed, is indefinite.

Applicant argues that the Bamber et al reference does not anticipate amended claim 1, because it produces only 400 to 500 lux – enough to light an average room, for example a 10 by

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10 foot room. However, as shown by the page submitted by applicant, this is to light an average room. If the flashlight of Bamber et al were used in a manner similar to applicant's – with the device pointed into the eyes and held 6 to 12 inches from the face, one fifth of the distance that the light of Bamber et al would be from each wall of an average room (since it would be in the center of the room, in order to provide the entire room with uniform illumination) the level of light would then be 2,000-2,500 lux, as claimed.

As to the Marsh device, applicant argues that such devices are not “hand held light output devices”. The examiner must respectfully disagree. Clearly the “EXIT signs, light bulbs, and mountable lamps” are all “hand-held” as they are capable of being held in the hand. If desired the examiner can provide affidavit evidence that he has seen mountable lamps, light bulbs, and EXIT signs held in the hand well prior to 1995, for example. Similarly, even a traffic light may be grasped in the hand and thus be considered “hand-held”. Thus these devices are clearly “hand-held” within the broadest reasonable definition of the term. With regard to the timer, since traffic lights are timed devices, they clearly include timers. Any flash light version of Marsh would read on the light output requirement by the same analysis as Bamber et al.

Turning to Kulebs, applicant argues that “The patio umbrella of Kulebs could hardly be considered to be hand-held”, however applicant admits that “the patio umbrella of Kulebs is portable”. The examiner submits that as Kulebs does not disclose any unusual method of moving the umbrella from place to place (e.g. balancing it on the head), one of ordinary skill in the art would readily understand that the device would be moved about in the conventional fashion: by being carried (held) in the hand. Thus the device of Kulebs is undeniably “hand-held”. Applicant also argues that the examiner's assertion that the light of Kulebs would be

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greater than 10,000 lux “is not true.” The examiner must respectfully disagree. A careful reading of the Kulebs reference will show that not only does Kulebs provide for the intensity of the light to be adjusted, but also that light outputs of 20,000-100,000 cd/m² are contemplated (see column 16, line 3). With respect to claim 4, it is noted that any two radially situated bulbs could be considered “parallel” for the purpose of reading on a claim requiring a plurality (i.e. two or more) of light sources arranged in parallel, however, more to the point, a further careful reading of the Kulebs reference will also reveal that Kulebs contemplates multiple bulbs in a single rib of the umbrella, which bulbs would also be arranged in parallel (see column 9, lines 40-50 and Figure 4A).

Regarding claim 21 and its dependants, applicant has stated that white light is suitable for ocular therapy, clearly applicant cannot be including the level of illuminance, in the term “suitable for ocular therapy” as this property of the light is specifically excluded in the claim language itself: “light sources...that output light **suitable for ocular therapy and of about 2,500 lux...**” (emphasis added); applicant had further provided no general disclosure concerning, nor particular modification to effect the output of “white light” by the CCFL bulbs, therefore the CCFL bulbs of Kulebs are considered to output “white light” which is suitable for ocular therapy in the same manner as the CCFL bulbs of applicant.

As to claim 83, the examiner respectfully notes that the shaft portion of the Kulebs device covers the lights when the umbrella is closed and also serves as a portion of the base which supports the device. Thus claims 83 and 85 are clearly anticipated by Kulebs. The cross base rests flat on the ground, as can be seen from Figures 2B and 2C, thus anticipating claim 84.

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Concerning the rejection under 35 USC 103, applicant argues that the combination applied to the claims does not provide a *prima facie* case of obviousness because one having ordinary skill in the art of light therapy devices would not apply the teachings from laptop computers and other portable electronic devices with LCD screens to light therapy devices. However this is not the threshold for a *prima facie* case of obviousness. It is not necessary, when rejecting an apparatus claim, for the examiner to show that the one having ordinary skill in the art would wish to produce a device to perform the method of applicant, merely that one of ordinary skill in the art would be motivated to produce a device as claimed, regardless of the use one would envision putting the device to, once it was constructed. As set forth above, the illuminance being specifically excluded from the characteristics of light "suitable for ocular therapy", does not affect claims which do not recite a particular range of illuminance.

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The examiner has taken official notice of the use of clamshell-type cases, which are notorious in the art for smaller computers, e.g. lap tops or handhelds such as the HP Jornada 720, as they protect the display and keep the keyboard dry and clean during periods when the device is not being employed for input or display; and the include an inverter, since these are needed for running CCFLs from DC sources. Applicant has not challenged the examiner's holding, thus this is considered to be admitted prior art (MPEP 2144.03).

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "hardware in the data processor" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The amendments filed July 8, 2005 and October 17, 2006 are objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "hardware in the data processor for processing the data input to calculate the amount and timing of therapeutic ocular

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light” (July 8, 2005) and “output light...of about 2,500 lux or less at a distance of about 6 inches to about 12 inches from the plurality of light sources” (October 17, 2006).

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-25, 57-72, 81, and 86 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The originally filed disclosure is silent on “hardware in the data processor” and “output light...of about 2,500 lux or less at a distance of about 6 inches to about 12 inches from the plurality of light sources”.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 56, 59, 60, 62, 63, 65-68, 72, 78, 79, 81-85, 88, and 91 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 56, 59, 60, 62, 63, 65-68, 72, 78, 79, 83-85, 88, and 91 are indefinite as they fail to further limit the claim from which they depend, as what further structural limitation is intended to be expressed by claiming the type of data input or the devices the processor is

envisioned to control and the manner in which it is envisioned to control them is unclear and therefore what further limitation is intended to be implied is unclear. In claim 66 the exact meaning of the term "that is to be delivered" is unclear. In claims 81 and 82 "the data input" and "the amount and timing of therapeutic ocular light" lack positive antecedent basis.

Claims 1, 12, 19, 56, and 57 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Bamber et al.

Elements 15 and 16 are each light sources.

Claims 87-92 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Whitcher.

See figure 3 and column 1, line 31 to column 6, line 23.

Claims 1-5, 11, 13, 18-21, 24, 56, and 57 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Marsh.

See figures 3-15; column 1, line 54 to column 4, line 39 and column 8, line 65 to column 12, line 22.

Claims 1-4, 7-13, 19, 21, 24, 56, 57, 70-75, 83-88, 90, 91, and 92 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Kuelbs.

See figures 1-4C, 10 and 11; column 1, line 30-60; column 3, lines 49 to column 10, line 68; column 14, line 28 to 65; and column 16, lines 19 to 45.

Claims 83-85, 87, 88, 90, 91, and 93-97 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Yano et al.

See figures 14A to 22C and column 8, line 3 to column 18, line 20.

Claims 1, 2, 4-6, 13-18 and 21-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whitcher et al in combination with Arao et al, HP Jornada 700 Series Handheld PC Users Guide and the admitted prior art that inverters are needed for running CCFLs from DC sources. Whitcher et al teach a handheld device which outcast a full range of color; has a battery pack; is computer controlled; and is illuminated by a CCFL. Arao et al teach the use of multiple CCFLs and reflectors in a light output module. It would have been obvious to the artisan of ordinary skill to employ the output device of Arao et al in the device of Whitcher et al, since Whitcher et al teach no particulars of the output device and since the output device of Arao et al is intended to be employed in this type of device (see Figures 25A-C) or, to employ the device of Whitcher et al as the driver for the output of Arao et al, since Arao et al give no details of the driver device shown in Figures 25A-C and since the device of Whitcher et al is shock resistant and versatile, and in either case to include an inverter, since these are needed for running CCFLs from DC sources, official notice of which has already been taken, to include means for receiving data from external sources, such as disk drives, since these are notorious devices routinely included in computers, official notice of which is hereby taken, and to employ standard energy saving features, such as a selectable level of screen illumination and a timer that turns off the display after a predetermined time of inactivity, since this conserves battery power, as shown by HP Jornada 700 Series Handheld PC Users Guide, which display controlling will require controlling the inverter, thus producing a device such as claimed.

Claims 1-3, 12-21, 24, 25, 56-69, and 76-82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whitcher et al in combination with Terman et al and the admitted prior art that employing a clamshell-type case, is notorious in the art for smaller computers, e.g. lap tops or

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handhelds such as the HP Jornada 720, as they protect the display and keep the keyboard dry and clean during periods when the device is not being employed for input or display. Whitcher et al teach a handheld device which outputs a full range of color; has a battery pack; is computer controlled; and is illuminated by a CCFL. Terman et al teach the use of a computer to control lighting as claimed. It would have been obvious to the artisan of ordinary skill to employ the programming, lighting, and control devices of Terman et al in the device of Whitcher et al, since Whitcher et al teach no particulars of the programming or peripherals and to include multiple CCFLs, since this would provide more even illumination of the screen, or to employ the device of Whitcher et al as the driver for the output of Terman et al, since Terman et al teach that any type of driver device can be used and since the device of Whitcher et al is shock resistant and versatile, wherein stopping or modifying the power from the inverter is considered "controlling the inverter"; and in either case to employ a clamshell-type case, as these are notorious in the art for smaller computers, e.g. lap tops or handhelds such as the HP Jornada 720, as they protect the display and keep the keyboard dry and clean during periods when the device is not being employed for input or display, official notice of which has already been taken, thus producing a device such as claimed.

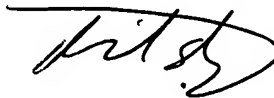
Any inquiry concerning this communication or earlier communications from the examiner should be directed to david shay whose telephone number is (571) 272-4773. The examiner can normally be reached on Tuesday through Friday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor, II, can be reached on Monday, Tuesday, Wednesday, Thursday, and

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Friday. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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